

Mail Stop Interference
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Filed 4 August 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Merck and Co., Inc.
Junior Party
(U.S. Patent Application 10/587,601),

v.

Japan Tobacco Inc.
Senior Party
(U.S. Patent 7,211,572).

Patent Interference No. 105,655 (MPT)
(Technology Center 1600)

DECLARATION - Bd.R. 203(b)¹

1 **Part A. Declaration of interference**

2 An interference is declared (35 U.S.C. § 135(a)) between the above-
3 identified parties. Details of the application(s), patent (if any), reissue application

¹ "Bd.R. x" may be used as shorthand for "37 C.F.R. § 41.x". 69 Fed. Reg. 49960, 49961 (12 Aug. 2004).

(if any), count(s) and claims designated as corresponding or as not corresponding to the count(s) appear in Parts E and F of this DECLARATION.

Part B. Judge managing the interference

Administrative Patent Judge Michael P. Tierney has been designated to manage the interference. Bd. R. 104(a).

Part C. Standing order

A Trial Section STANDING ORDER [SO] (Paper 2) accompanies this DECLARATION. The STANDING ORDER applies to this interference.

Part D. Initial conference call

A telephone conference call to discuss the interference is set for **2:00 p.m.** on **September 17, 2008** (the Board will initiate the call).

No later than four business days prior to the conference call, each party shall file and serve (SO ¶¶ 10.1 & 105) a list of the motions (Bd. R. 120; Bd. R. 204; SO ¶¶ 104.2.1, 120 & 204) the party intends to file.

A sample schedule for taking action during the motion phase appears as Form 2 in the STANDING ORDER. Counsel are encouraged to discuss the schedule prior to the conference call and to agree on dates for taking action. A typical motion period lasts approximately eight (8) months. Counsel should be prepared to justify any request for a shorter or longer period.

Part E. Identification and order of the parties

Junior Party

Named Inventor: PHILIP JONES, POMEZIA, ITALY
VINCENZO SUMMA, POMEZIA, ITALY
MONICA DONGHI, POMEZIA, ITALY
CRISTINA GARDELLI, POMEZIA, ITALY

Involved Application: U.S. Application 10/587,601, filed July 28, 2006

Title: HIV INTEGRASE INHIBITORS

Assignee: Merck and Co., Inc.

Senior Party

Named Inventors: SUSUMU MIYAZAKI, OSAKA, JAPAN
SUSUMU KATOH, OSAKA, JAPAN
KAORU ADACHI, OSAKA, JAPAN
HIROTAKA ISOSHIMA, OSAKA, JAPAN
SATORU KOBAYASHI, OSAKA, JAPAN
YUJI MATSUZAKI, OSAKA, JAPAN
WATARU WATANABE, OSAKA, JAPAN
KAZUNOBU YAMATAKA, OSAKA, JAPAN
SHINICHI KIYONARI, OSAKA, JAPAN
SHUICHI WAMAKI, OSAKA, JAPAN

Involved Patent: U.S. Patent No. 7,221,572, issued on May 1, 2007, based
upon U.S. Application No. 11/255,605, filed October 13,
2005.

1 Title: NITROGEN-CONTAINING FUSED RING
2 COMPOUND AND USE THEREOF AS HIV
3 INTEGRASE INHIBITOR

4 Assignee: Japan Tobacco Inc.
5

6 The senior party is assigned exhibit numbers 1001-1999. The junior party is
7 assigned exhibit numbers 2001-2999. Bd. R. 154(c)(1); SO ¶ 154.2.1. The senior
8 party is responsible for initiating settlement discussions. SO ¶ 126.1.
9

10 **Part F. Count and claims of the parties**

11 Count 1

12 A compound according to claim 1 of U.S. Patent 7,211,572 or according to
13 claim 1 of U.S. Application 10/587,601 wherein the compound is an HIV integrase
14 inhibitor.
15

16 The claims of the parties are:

17 JP Tobacco Inc, U.S. Patent 7,211,572: 1 and 2

18 Merck and Co., Inc., U.S Application 10/587,601: 1-16, 18 and 23
19

20 The claims of the parties which correspond to Count 1 are:

21 JP Tobacco Inc, U.S. Patent 7,211,572: 1 and 2

22 Merck and Co., Inc., U.S Application 10/587,601: 1-16, 18 and 23
23
24
25

1 The claims of the parties which do not correspond to Count 1, and therefore
2 are not involved in the interference, are:

3 JP Tobacco Inc, U.S. Patent 7,211,572: None

4 Merck and Co., Inc., U.S Application 10/587,601: None

5
6 The parties are accorded the following benefit for Count 1:

7 Merck and Co., Inc.:

8 i) PCT/GB05/00746, filed March 1, 2005

9 ii) U.S. Provisional Application 60/551,601, filed **March 9, 2004**.

10
11 Japan Tobacco Inc.:

12 i) U.S. Application 10/958,225, filed October 5, 2004;

13 ii) PCT/JP04/11869, filed August 12, 2004;

14 iii) JP 2004-134896, filed April 28, 2004;

15 iv) JP 2003-293117, filed **August 13, 2003**.

Part G. Heading to be used on papers

The following heading must be used on all papers filed in this interference,
see SO ¶ 106.1.1:

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Part H. Order form for requesting file copies

When requesting copies of files, use of SO Form 4 will greatly expedite processing of the request. Please attach a copy of Parts E and F of this DECLARATION with a hand-drawn circle around the patents and applications for which a copy of a file wrapper is requested.

**/Michael P. Tierney/
Administrative Patent Judge**

Enc:

Copy of STANDING ORDER
Copy U.S. Patent 7,211,572
Copy of claims of 10/587,601
Copy of PTO-850

Revised 3 January 2006

